

Remarks:

Claims 1-25 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1-8, 12, 17, 19-23, and 25 are amended. Claims 9-11, 15, 16, 18, and 24 are canceled. Claim 26 is added. No new matter is added as support for the amendments is found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

On page 2 of the Office Action, the Examiner states that the references disclose all the functional components that allow them to be "...capable of..." of all the functionalities of Applicant's invention. Applicant has amended the claims to more distinctively claim the subject matter of the invention.

§102 Rejection(s):

Claims 17 and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,714,797 to Rautila (hereafter "Rautila"). This ground of rejection is respectfully traversed.

Anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131. Also, anticipation of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." MPEP §2125.

Rautila discloses a method for ordering, paying for, and downloading digital products to a mobile device in a cost-effective manner. The mobile device accesses websites listing digital products for sale using a wide area network connection, but downloads the digital products from hotspot network locations using a short-range network connection. Thus, a user of the mobile

device may download large amounts of digital data without incurring telephone or cellular phone charges. See *Rautila*, Abstract; column 2, lines 56-67; and column 3, lines 1-38.

Rautila fails to disclose at least one of the elements recited in claim 22, as amended. In particular, Rautila fails to disclose a method comprising “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services in a wide area network,” as recited in amended claim 22.

Further, Rautila directly teaches away from the elements recited in claim 22. Rautila discloses hotspot network locations (i.e., terminals) that directly access websites (i.e., services in a wide area network) to download digital products. Claim 22, on the other hand, recites a wireless device providing terminals with in direct access to services in a wide area network.

Moreover, Rautila is directed to avoiding downloading of data from websites to minimize communication with a wide area network in order to reduce data transmission costs. Claim 22, on the other hand, is directed to providing terminals with simultaneous access to services in a wide area network, or expanding communication with the wide area network.

Accordingly, since Rautila fails to disclose at least one of the elements recited in claim 22 and further teaches away from the elements recited in claim 22, the §102 ground of rejection should be withdrawn.

§103 Rejection(s):

Claims 1-8, 11, 12, 14, and 19-25 are rejected under §103(a) as being unpatentable over Rautila in view of U.S. Patent No. 7,212,785 to Brassil et al. (hereafter “Brassil”). Claims 9, 10, 13, 15, and 16 are rejected under §103(a) as being unpatentable over Rautila in view of well-known prior art. These grounds of rejection are respectfully traversed.

MPEP §2143 provides:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Brassil discloses a short-range, high-speed wireless network comprising a first device and a second device. The first device communicates with the second device to determine whether the second device has data required by the first device. Upon determining that the second device has the required data, the first device communicates with a service provider over a long-range, slow-speed network to request permission to download the first data from second device. If the request is approved, the service provider transmits permission to the first device and transfers the required data from the second device to the first device. See Abstract and column 1, lines 25-59.

Brassil fails to disclose at least one of the elements recited in claim 1, as amended. In particular, Brassil fails to disclose a method comprising “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services in a wide area network,” as recited in amended claim 22. Thus, Brassil fails to cure the deficiencies of Rautila, as Brassil also fails to disclose “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services in a wide area network.”

The simultaneous connection disclosed in Brassil is not equivalent to the simultaneous access recited in claim 22. Brassil discloses a short-range wireless network comprising communication devices that may be connected to each other simultaneously (e.g., a Bluetooth network may support up to 8 simultaneous devices). See column 1, lines 5-23. That is, Brassil discloses devices that are simultaneously connected only within a short-distance wireless network. Claim 22, on the other hand, recites simultaneous access to services in a wide area network.

Further, a person of ordinary skill in the art would not have been motivated to modify or combine Brassil with Rautila since Rautila teaches away from the elements recited in claim 22. Moreover, Brassil also teaches away from the elements recited in claim 22. Brassil is directed to using a short-range, high-speed connection to download data, limiting use of a long-range, slow-

speed connection to requesting permission to download from a service provider. Claim 22, on the other hand, is directed to providing terminals with simultaneous access to services in a wide area network, or expanding communication with the wide area network.

The well-known prior art fails to disclose at least one of the elements recited in claim 22, as amended. In particular, the well-known prior art fails to disclose a method comprising “connecting to a plurality of terminals in a short distance wireless network; and providing the terminals in the short distance wireless network with simultaneous access to a plurality of services in a wide area network,” as recited in amended claim 22. Thus, the well-known prior art fails to cure the deficiencies of Rautila, as the well-known prior art also fails to disclose “providing the terminals in the short distance wireless network with simultaneous access to a plurality of services in a wide area network,” as recited in amended claim 22.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant’s disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner’s statements regarding obviousness and

motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 grounds of rejection be withdrawn.

For the above reasons, neither Rautila, Brassil, nor the well-known prior art, either alone or in combination, teach or suggest the elements recited in claim 22. Therefore, it is respectfully submitted that claim 22 is in condition for allowance. Claim 23 depends on claim 22 and should be in condition for allowance by the virtue of its dependence on an allowable base claim. Amended claims 1, 17, and 25 substantially incorporate the elements of claim 22; therefore, claims 1-8, 12-14, 19-23, and 26 depending from claims 1, 17, and 25 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789-2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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